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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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|-----------------|-------------|----------------------|---------------------|------------------|

10/806,924

03/22/2004

Mario Geysen

17102-011001 / 1760

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05/19/2006

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EXAMINER

WESSENDORF, TERESA D

ART UNIT

PAPER NUMBER

1639

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/806,924 | Applicant(s) GEYSEN ET AL. | |
| | Examiner T. D. Wessendorf | Art Unit 1639 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final *for restriction only*.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-64 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-18, drawn to a collection of antigenic polypeptide, classified in class 435, subclass 7.1.
- II. Claims 1 and 19, drawn to a collection of antigenic polypeptide conjugated to a molecule, classified in class 435, subclass 4+.
- III. Claims 20-21, drawn to a collection of capture agent-binding partner polypeptide pairs, classified in class 435, subclass 7.1.
- IV. Claims 20 and 22-23, drawn to a collection of binding partners having any one of the recited sequences, classified in class 435, subclass 7.1..
- V. Claims 24 and 25, drawn to a fusion protein, classified in class 530, subclass 350.
- VI. Claims 26-43, drawn to a method of generating antigen polypeptides, classified in class 435, subclass 4+.
- VII. Claim 44, drawn to a collection of binding partner polypeptides, classified in class 435, subclass 7.1.

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- VIII. Claim 45, drawn to a collection of capture agent-binding partner polypeptide pairs, classified in class 435, subclass 7.1.
- IX. Claim 46, drawn to a kit, classified in class 435, subclass 7.1.
- X. Claims 47-57, drawn to a method for synthesizing an addressable collection of polypeptides, classified in class 435, subclass 4+.
- XI. Claims 58-64, drawn to a method for synthesizing an addressable collection of molecules, classified in class 435, subclass 4+.

The inventions are distinct, each from the other because of the following reasons:

Inventions VI, X and XI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are drawn to different methods comprising different steps and/or components with different results and/or effects. For example, the method of Group VI is directed to a method of generating antigen polypeptides. Group X relates to a method of making specifically

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a peptide. The method of Group XI is drawn to synthesis of a molecule.

Inventions I-V and VII-IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are drawn to e.g., structurally different compounds or collection of polypeptides. For example, Group I is directed to a collection of antigenic polypeptide. Group II requires an additional component conjugate e.g., polypeptides, nucleic acid and small organic molecules. Group III is drawn to polypeptide pairs. Group IV requires the specifics of a sequence, i.e., Seq. ID. Nos. 1-911. Group V relates to a fusion protein.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and each of the inventions require a different field of search (see MPEP § 808.02), specifically the different literature journals, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species:

For Group I:

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1. The at least four residues from E, P, Q, N and so forth.
2. Length of the polypeptides as recited in *e.g.*, claim 9.
3. Library (*e.g.*, nucleic acid, polypeptide, natural products and etc.) as recited in claim 18.

For Group II:

1. The at least four residues from E, P, Q, N and so forth.
2. Length of the polypeptides as recited in *e.g.*, claim 9.
3. Library (*e.g.*, nucleic acid, polypeptide, natural products and etc.) as recited in claim 18.

4. A conjugate (*e.g.*, polypeptides, nucleic acids and so on) as recited in claim 19.

For Group III:

1. The at least four residues from E, P, Q, N and so forth.
2. Length of the polypeptides as recited in *e.g.*, claim 9.

For Group IV or V:

1. The at least four residues from E, P, Q, N and so forth.
2. Length of the polypeptides as recited in *e.g.*, claim 9.
3. Seq. ID. Nos. 1-911 (only one Seq. ID. No.) as recited in claim 22.

For Group VI, VII, VIII and IX:

1. The amino acids length(m) and number (n) and kind(as recited in claim 31).

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2. Critical or non-critical residues (specify the kind, length and number of amino acids for either the critical or non-critical residues).

3. The integer *r* as recited in claim 39, for example.

4. The integer *q* as recited in claim 41.

For Group X:

1. Collection of molecules

2. Length of polypeptide

Group XI:

1. Molecules as recited in claim 59

2. Starting molecule

3. Polypeptide of Seq. ID. Nos. 1-911

The species are independent or distinct because each of the species recited in e.g., Group I differs in structure e.g., library) and length or numbers of amino acids in the polypeptide sequences. A prior art reference anticipating one of the species would not render obvious the other species.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species (e.g., for Group I, one species from 1, one from 2 and one from 3) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 19, 20, 22, 24, 25, 26, 47 and 58 are generic.

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Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant(s) traverse on the ground that the species are not patentably distinct, applicant(s) should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant(s) is/are advised that the reply to this requirement to be complete must include an election of the

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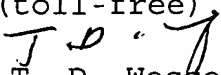
invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant(s) is/are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to T. D. Wessendorf whose telephone number is (571)272-0812. The examiner can normally be reached on Flexitime.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Paras can be reached on (571)272-4517. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


T. D. Wessendorf
Primary Examiner
Art Unit 1639

tdw
May 15, 2006